

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : PRISTINE, Gorsev
APPLICATION NO. : 10/733,345
TITLE : SYSTEM AND METHOD FOR INTAKE OF A PATIENT IN
A HOSPITAL EMERGENCY ROOM
FILING DATE : December 12, 2003
EXAMINER : ALTSCHUL, Amber L.
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the final rejection of January 21, 2010 in the above-identified application (the "Office Action"). This request is being filed concurrently with a Notice of Appeal, and no amendments are being filed with the Request. Claims 1-18 are pending in the application. Claims 1, 8, 15 and 16 are independent.

Claim Rejections

Claims 1-18 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2002/0077865 (Sullivan) in view of U.S. Patent No. 6,151,581 (Kraftson).

Issues

Applicant's request for review centers on the Examiner's failure to meet the legal requirements necessary to support the above-mentioned claim rejections.

In particular, the asserted combination of Sullivan and Kraftson lacks at least one limitation of each of the rejected claims. Further, the requisite rational underpinning in support of the asserted combination of art has not been provided. In addition to the reasons presented below, Applicant relies on the arguments set out in the Amendment of October 8, 2009 ("Amendment").

Detailed Arguments

Missing Limitations

Applicant notes that in order to maintain a rejection under 35 U.S.C. 103, the Examiner must show that the asserted combination of art satisfies each and every limitation of the claim. Applicant submits that the Examiner has not made this showing, and that the claim rejections therefore cannot be maintained.

the Examiner conceded at page 3 of the Office Action that Sullivan fails to satisfy the following limitation of claim 1:

"...further operable to present on said touch screen at least one main question and a plurality of dependent questions presented based on a response to said main question and responses to previous dependent questions..."

The Examiner asserted that Kraftson discloses the above-recited limitation at column 6, lines 19-31 and at column 22, lines 42-58. As submitted in Applicant's previous correspondence, the cited portion of Kraftson's column 6 merely describes the handling of electronic forms. No mention is made of a main question or any dependent questions as recited in claim 1. In fact, Kraftson does not discuss "questions" of any sort in that passage. The second passage describes Kraftson's Figure 21, which shows "a sub-routine program which enables data entry for **a predetermined set** of survey questions which have yes/no answers" (*emphasis added*). The flowchart of Figure 21 shows that if a

"No" value is detected at step 2106, a database is updated and the next form is loaded. If a "Yes" value is detected at step 2106, the database is updated and the "last form of the group" is loaded. Thus, which form to load next is determined only once, solely on the basis of the yes/no answer to a **single** question. Kraftson's "form Q12" is described as the last form in a group, suggesting that there would be no opportunity for further questions. Kraftson does not provide any discussion of the handling of "form Q10" (described as the "next form"). In contrast, Applicant's Figures 6-8 show a succession of questions in which each succeeding question is based on earlier responses. Thus, Kraftson fails to provide a computing device operable to present questions based on a response to a main question **and** responses to previous dependent questions.

Both Sullivan and Kraftson therefore fail to satisfy the above-recited limitation of claim 1. As no other teaching of this limitation was asserted, the rejection under 35 U.S.C. 103 cannot be maintained and should be withdrawn.

In addition to the above, Applicant submits that Sullivan and Kraftson also fail to satisfy at least the following limitation of claim 1:

"said device further operable to generate an intake report based on said responses in a preferred language of a hospital staff member responsible for further processing of said intake of said patient"

The Examiner alleged that the above-recited limitation is provided by Sullivan's abstract, paragraph 125 and paragraphs 132-134. As argued previously in the Amendment, the cited portions of Sullivan make no mention of intake reports. Indeed, Sullivan provides reports that **cannot** be intake reports, as they depend entirely on events which take place **after** patient intake, such as patient discharge, for example (see paragraph [0132] of Sullivan). Sullivan's reports, as described at paragraph 134, are used for the purposes of "assessments,

teaching, litigation, etc. regarding what actions were specifically taken by the user, and whether certain observations were made." There cannot have been any "actions taken by the user" until **after** patient intake is already complete.

Kraftson also fails to make any mention of intake reports. On the contrary, the forms mentioned by Kraftson are for completion **during** a treatment session (column 6, lines 2-3), which is necessarily after patient intake. Thus, neither Sullivan nor Kraftson provide a device operable to generate an intake report, as recited in claim 1. The rejection of claim 1 therefore cannot be maintained and should be withdrawn.

Lack of Rational Underpinning

Applicant also notes that in order to support a rejection under 35 U.S.C. 103, the Examiner must furnish articulated reasoning to support the legal conclusion of obviousness as required by *KSR International Co. v. Teleflex Inc.* The Examiner stated at page 3 of the Office Action that it would be obvious to combine Sullivan and Kraftson and that "the motivation would have been to provide the most effective treatment for a disease or patient problem." It therefore appears that the combination of Sullivan and Kraftson is based on a teaching, suggestion or motivation analysis, which must be supported by evidence and reasoned argument that there was a teaching, suggestion or motivation to select and combine features from the cited references. E.g., *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover, the prior art must suggest the **desirability** of the combination, not merely the feasibility. *In re Fulton*, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004).

The Examiner's stated motivation to combine Sullivan and Kraftson is no more than a line reproduced from Kraftson. No evidence or reasoned argument was presented in support of the stated motivation. Further, no arguments were

provided in support of the position that the prior art suggests the feasibility and the desirability of such a combination. The rejection of claim 1 therefore cannot be maintained for at least the above reasons, and should be withdrawn.

Claim 1 is therefore patentable for at least the above reasons, as are claims 8, 15 and 16 which recite similar limitations to those of claim 1. All remaining claims are dependent on one of claims 1 and 16, and are therefore also patentable for at least the above reasons.

In view of the above arguments, reconsideration and allowance of the subject claims are respectfully requested.

The Commissioner is also authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-3750.

Respectfully submitted,



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